

### REMARKS

The Office Action dated May 3, 2005 has been received and carefully studied.

The Examiner maintains the rejection of claims 9, 12 and 13 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the limitation "discrete regions separately removable from said base", when combined with the limitations of the instant claims, could be interpreted as "discrete regions having sub-regions separately removable from the base", which is not supported by the original disclosure.

Although Applicants continue to disagree with the rejection, in order to expedite allowance claim 9 now has been amended into independent form and does not include the language that at least one of the discrete regions is separately removable from the base. It is believed that the amendment overcomes the rejection.

The Examiner rejects claims 1-4 and 7-13 under 35 U.S.C. §102(b) as being anticipated by Kroy, et al., U.S. Patent No. 5,252,294. The Examiner states that Kroy discloses a device having all of the limitations of these claims. The Examiner relies on *Garnder v. TEC Systems, Inc.*, 220 U.S.P.Q. 777 (Fed. Cir. 2984) in support of his position that were the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than

the prior art device, the claimed device was not patentably distinct from the prior art device.

The rejection is respectfully traversed.

In *Gardner*, certain claimed dimensions of an air bar were found to provide no performance difference compared with a prior art air bar not having those dimensions. This finding led to the decision as articulated above. In contrast, in the instant claims, however, the recited spacing multiple is not merely a single integer, but is a multiple of 2.25 that is critical in enabling the device to be used in automated equipment. This is not possible with the Kroy device. In view of the fact that the instant device has the recited dimensions, it functions differently in automated equipment than the Kroy device. Accordingly, Applicants respectfully submit that the recited dimensions are a patentable distinction.

Moreover, Applicants again respectfully submit that Kroy does not teach a structure having utilitarian discontinuities in discrete regions with different functionalities. Kroy teaches micromechanical structure that can be used for a variety of different tests, but does not teach multiple functionalities within the same structure.

The Examiner maintains the rejection of claim 5 under 35 U.S.C. §103(a) as being unpatentable over Kroy et al. in view of Sarrasin, U.S. Patent No. 5,009,780. Claim 5 is believed to be allowable by virtue of its dependent, for the reasons stated

above.

The Examiner also rejects claims 1, 2 and 9-13 under 35 U.S.C. §103(a) as being anticipated by (sic, as being unpatentable over) Nguyen et al. in view of Kroy. The Examiner states that Nguyen teaches multiple discrete regions and sub-regions, but does not teach that they are separately removable. The Examiner again cites Kroy as teaching the separately removable limitation.

The rejection is respectfully traversed.


Nowhere does Nguyen et al., alone or in combination, teach the spacing of the utilitarian discontinuities as recited in the instant claims in order to retain the same overall footprint of the device so that it can function in standardized automated equipment. Although standardized automated equipment is involved in Nguyen, the function of the disclosed block is for maintenance, calibration and validation of the equipment. To that end, the various utilitarian discontinuities need not be spaced in any particular array, since the block is not used when the equipment is in a testing mode, but rather when it is "off-line" using specific user-directed software.

Furthermore, with respect to the Examiner's position that Kroy motivates making the discontinuities separately removable, Applicants respectfully submit that Kroy's statement that the carrier is for transportation to a plurality of stations for automated testing in claim 15 does not support the Examiner's position. Claim 15 relates to masked-formed etched structures

that are fixed onto a film carrier. It is completely silent as to an separately removable feature, and indeed is just the opposite, the structures are fixed. In addition, the Examiner's reliance on the Kroy disclosure at column 1, lines 33-36 that it is object of the Kroy invention to facilitate or ensure clean, safe storage and handling of substances which are dangerous has nothing to do with separate removability. Indeed, the removability feature of the Kroy device is discussed only in the context of Figure 14, and in particular, the macrochips that are cemented or fastened detachably to the film carrier. Certainly these are not ``dangerous materials''. Lastly, nothing in Kroy suggests any reasons for making the utilitarian discontinuities of Nguyen separately removable.

Reconsideration and allowance are respectfully requested in view of the foregoing.

Respectfully submitted,

  
Kevin S. Lemack  
Reg. No. 32,579  
176 E. Main Street - Suite 7  
Westboro, Massachusetts 01581  
TEL: (508)898-1818